

## REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested.

Claims 9-14 were in the application, claims 9 and 11 have been amended.

Claims 9 and 11 have been amended to remove the alternative language, and in particular, claims 9 and 11 have been amended to remove the phrase a "predetermined number of rotations", in favor of an evaluation after "a selected rotation time". As this amendment reduces claim scope in a way which does not necessitate a new search, entry is proper and is requested. More particularly, entry of the amendment moots at least the rejection of claims 9-12 as being anticipated by Simon, and so reduces the issues for appeal and/or places the application in condition for allowance.

Entry is proper in accordance with MPEP 714.12:

"Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments filed after a final rejection, but before or on the date of filing an appeal, complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b)"

As claim 9 has been amended to remove the alternative language, and in particular, the number of rotation alternative, the rejection of claims 9-12 under 35 USC 102(b) over Simon, DE 19521924 has been rendered moot.

More particularly, each and every element of claims 9-12 are not found in Simon, as Simon does not use a single reference point for determining whether a container has been successfully capped.

Similarly, as claim 11 has been amended to remove the alternative language, and in particular, the number of rotations alternative, the rejection of claim 11 under 35 USC 102(b) over Spatz, et al, US 5,321,935 is believed to

have been rendered moot.

"The term "anticipation" in patent usage means that the invention was previously known to the public; that is, that it previously existed in the precise form in which it is claimed, including all of the limitations in the claim."

SmithKline Beecham Corp. v. Apotex Corp., 439 F.3d 1312, 1324 (Fed. Cir. 2006) (Emphasis Added.)

"A claim cannot be 'anticipated' by prior art that does not have all of the limitations in the claim." *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000) *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1324 (Fed. Cir. 2006)

In this case, all the elements of amended claim 11 are not found in Spatz, precisely as presented in amended claim 11, and so claim 11 is not anticipated thereby.

Claims 9, 10 and 12 were rejected as being obvious over Spatz, et al in view of Simon, and further in view of the admitted prior art.

In conducting an obviousness analysis, "[a] fact finder should be aware . . . of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 167 L. Ed. 2d 705 (2007). This is because the genius of invention is often a combination of known elements that in hindsight seems preordained. In re Omeprazole Patent Litig., No. MDL 1291, 490 F. Supp. 2d 381, 2007 U.S. Dist. LEXIS 39670, at 400-01 (S.D.N.Y. May 31, 2007) (citation omitted) (quoting KSR, 127 S.Ct at 1742); see also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985), *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 961 (Fed. Cir. 1983) (stating that "virtually every claimed invention is a combination of old elements").

The Court in KSR also wrote, "[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741, 167 L. Ed. 2d 705 (2007) ("To facilitate review, this analysis should be made explicit.") (citing Kahn, 441 F.3d at 988... "there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006).

If the prior art teaches away from combining known elements in the manner claimed by the invention at issue, discovering a successful way to combine them is less likely to be obvious. See KSR Int'l, 127 S. Ct. at 1740, 1745.

The KSR decision, while instructive, is readily distinguishable from the facts here. Most importantly, more than a combination of known elements is involved, as independent claims 9 and 11 includes elements and steps not found in the prior art.

For example, Spatz utilizes multiple moment comparisons to determine whether a proper capping has been achieved. For example, there is the application moment M1, , described in col. 5, lines 1-9 referred to by the examiner, where it is stated: "Instead of presetting a specific time period, which is allowed at the most to elapse before the application moment is reached, ...". In other words, there is first a comparison to determine if the application moment is reached, then the rotation sensor is activated, and the closure further rotated, to reach M2, the closure moment.

Spatz thus requires multiple steps, and multiple sensors for performing the cap closure.

On the other hand, the applicants' invention dispenses with the additional sensors, and additional steps presented by Spatz, and determines if the cap has been properly closed at a single point, that is, by determining if the closure torque was reached near the end of the preselected time.

Neither the method nor the apparatus of the invention are found in Simon, Spatz or the alleged admitted prior art. More importantly, Spatz teaches

away from the simpler less complicated system of the present invention, as one skilled in the art would be led to believe that the multiple sensors, and comparisons to different torque and angle settings are needed to assure proper cap closure. To arrive at the applicants' invention, the examiner must engage in a hindsight reconstruction, which is not permitted. Consequently, claims 9, 10 and 12 are not rendered obvious by the prior art.

Claims 13 and 14 were rejected as being obvious over Spatz or Simon in view of Oshima. However, these claims depend from and contain all the limitations of claim 11 therein, and the combination with Oshima does not overcome the deficiency in the rejection of claim 11 over the prior art as discussed above.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

The cited documents disclose methods and device in which the torque applied is detected by means of a torque detector.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

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